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CASE PH7087A CIP

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September 14, 2004
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1653

PRIESTLEY ET AL.

Examiner: David Lukton

APPLICATION NO: 10/010,184

FILED: DECEMBER 6, 2001

FOR: NOVEL LACTAM INHIBITORS OF HEPATITIS C VIRUS NS3 PROTEASE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

This is in response to the Office Action mailed June 10, 2004. Claims 1 to 26 are currently pending. Applicants thank the examiner for indicating the allowability of claims 1 to 8.

35 U.S.C. § 112, first paragraph

Claims 9 to 26 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention. Applicants respectfully request reconsideration and withdrawal of the rejection for the following reasons.

Although the examiner suggests that the inclusion of the phrase "therapeutically effective amount" and the term "pharmaceutical" render the claims non-enabled because one skilled in the art would allegedly not be able to practice the invention without engaging in undue experimentation, there has been no evidence provided to substantiate the suggestion. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. M.P.E.P. § 2164.01. Applicants have demonstrated that the compounds of the present invention have the ability to inhibit the N3 protease and therefore have the potential to treat HCV in a mammal. There has been no evidence or technical reasoning provided by the Office